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APPLICATION NO.	APPLICATION NO. FILING DATE		FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
10/806,870	10/806,870 03/23/2004		Paul B. Rivers	04-BS001 (BS030749)	2701	
38515	7590	07/12/2006		EXAM	INER	
BAMBI FA		ALTERS	CAJILIG, CH	CAJILIG, CHRISTINE T		
WILLIAMS		A 23188		ART UNIT	PAPER NUMBER	
,				3637	-	
			DATE MAILED: 07/12/2000	5		

Please find below and/or attached an Office communication concerning this application or proceeding.

		Applica	Application No. Applicant(s)						
Office Action Summary			870	RIVERS ET AL.	RIVERS ET AL.				
			er	Art Unit					
		Christine	e T. Cajilig	3637					
Period fo	The MAILING DATE of this communic or Reply	cation appears on t	he cover sheet v	with the correspondence ac	ddress				
WHIC - Exter after - If NC - Failu Any	ORTENED STATUTORY PERIOD FO CHEVER IS LONGER, FROM THE MA nsions of time may be available under the provisions of SIX (6) MONTHS from the mailing date of this commu operiod for reply is specified above, the maximum state re to reply within the set or extended period for reply we reply received by the Office later than three months afted ped patent term adjustment. See 37 CFR 1.704(b).	AILING DATE OF far the	THIS COMMUN event, however, may a will expire SIX (6) MC pplication to become A	IICATION. a reply be timely filed DNTHS from the mailing date of this of ABANDONED (35 U.S.C. § 133).	,				
Status									
1)⊠	Responsive to communication(s) filed	l on 23 March 200	4						
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ت (۵	closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.								
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Dispositi	on of Claims								
4)⊠	Claim(s) <u>1-20</u> is/are pending in the application.								
	4a) Of the above claim(s) 3,11,19 and 20 is/are withdrawn from consideration.								
5)[Claim(s) is/are allowed.								
6)⊠	Claim(s) <u>1,2,4-10 and 12-18</u> is/are rejected.								
7)🛛	Claim(s) <u>1,2,4-10 and 12-18</u> is/are objected to.								
8)□	Claim(s) are subject to restricti	ion and/or election	requirement.						
Applicati	on Papers								
9)🖂	The specification is objected to by the	Examiner.							
10)⊠ The drawing(s) filed on <u>23 March 2004</u> is/are: a)□ accepted or b)⊠ objected to by the Examiner.									
,—	Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).								
	Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).								
11)🛛	11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.								
	inder 35 U.S.C. § 119	•							
	Acknowledgment is made of a claim fo	or foreign priority u	indor 35 II S C	\$ 110(a) (d) or (f)					
	☐ All b)☐ Some * c)☐ None of:	or foreign priority u	11del 35 0.5.C.	9 119(a)-(d) of (1).					
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	2. Certified copies of the priority d3. Copies of the certified copies of			· ·	Ctoro				
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* 0	application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received.								
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	e of References Cited (PTO-892) e of Draftsperson's Patent Drawing Review (PT	O 048)		Summary (PTO-413)					
	e of Draftsperson's Patent Drawing Review (P10 nation Disclosure Statement(s) (PTO-1449 or P			o(s)/Mail Date Informal Patent Application (PTo	O-152)				
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DETAILED ACTION

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Election/Restrictions

- 1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-18, drawn to a wire channel device, classified in class 174.
 - Claims 19-20, drawn to a method for using a wire channel device, classified in class 52.
- 2. The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product as claimed can be used in a materially different process such as hooking onto the underside of a raised floor to form a baseboard.
- 3. Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.
- 4. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process

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claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

- 6. This application contains claims directed to the following patentably distinct species:
 - a. Species 1 Figures 3A, 3B, 4, and 5
 - b. Species 2 Figure 3C
 - c. Species 3 Figures 6,7,8A, 8B, and 9
- 7. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-2, 4-10, and 12-18 are generic.
- 8. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.
- 9. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations

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of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

- 10. During a telephone conversation with Ms. Bambi Walters on June 21, 2006 a provisional election was made without traverse to prosecute the invention of Species 3, claims 1-2, 4-10, and 12-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3, 11, 19, and 20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
- 11. Claim 3 is withdrawn as it refers to a rectangular-shaped channel.
- 12. Claim 11 is withdrawn as it refers to a triangular shaped lip.
- 13. Claims 19 and 20 are withdrawn as they refer to the method of using a wire channel device

Oath/Declaration

- 14. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.
- 15. The oath or declaration is defective because:

It does not identify the mailing address of each inventor. A mailing address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing address should include the ZIP Code designation. The mailing address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

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It does not identify the citizenship of each inventor.

Drawings

- 16. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 141 and 143. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filling date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
- 17. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the downwardly extending leg having a female repository on a first lateral side and a male projection on the second lateral side as stated in claims 16 and 18 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. The male projection and female repository are currently shown on the channel portion.
- 18. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

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replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

- 19. Applicant is reminded of the proper language and format for an abstract of the disclosure. The use of the word "invention" in the first and fourth lines of the abstract is improper.
- 20. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The

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abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

- 21. The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.
- 22. The disclosure is objected to because of the following informalities: Page 9, line 18 states that element 150 is the downwardly extending leg when in the beginning of the sentence in line 18, element 150 was called the rear upward extending leg; From paragraph 0020 and forward, element 146 is referred to as the transverse arm when it has been previously referred to as the transverse leg; Lines 10 and 11 of paragraph 0022 repeats the words "wire channel device wire channel device".

Appropriate correction is required.

Claim Objections

Claims 1, 2, 4-10, and 12-18 are objected to because of the following informalities: Claim numbering [C01, C02, C03] in brackets is not considered proper. The notation [C01] is not proper and should be spelled out as "Claim 1" or "1" would suffice. Appropriate correction is required.

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Claim Rejections - 35 USC § 112

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23. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

- 24. Claims 7-10, 13, 15, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- 25. The term "at least about" in claims 7-9 and the term "at least approximately" in claim 13 are relative terms, which renders the claim indefinite. The terms "about" and "approximately" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.
- 26. Claim 15 and accordingly, dependent claims 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is indefinite because the preamble only recites a wire channel device. However, the body of the claims positively recites a rearwardly facing hook portion of an upper siding panel and defines the placement of the wire channel device with respect to an upper siding panel. Therefore, it is unclear whether the claims are directing to a combination of the wire channel device and the upper siding panel or just a wire channel device per se. For purpose of examination the claims are considered as directed to the wire channel device.

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27. Claims 8 and 16 recite the limitation "the transverse arm" in the last line of the claim. There is insufficient antecedent basis for this limitation in the claim.

28. Claim 10 recites the limitation "the arm" in the last line o the claim. There is insufficient antecedent basis for this limitation in the claim. It is indefinite whether "the arm" refers to the transverse arm of the upwardly extending arm. For purpose of examination "the arm" is considered as directed to the upwardly extending arm.

Claim Rejections - 35 USC § 102

29. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- 30. Claims 1, 2 and 12-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Edwards (U.S. Patent No. 6,158,180).
- 31. Regarding claim 1, Edwards in Figure 6 discloses a wire channel comprising:
 - a. an upwardly extending arm (26) having a top portion (a), a bottom portion (b), an inner surface (c), and an outer surface (20), the outer surface (20) of the top portion (a) having a projection (30, 28) to engage and to secure the wire channel device between an upper siding panel and a lower siding panel. The phrase "to engage and to secure the wire channel device between an upper siding panel and a lower siding panel" is regarded to as functional language and while features of an apparatus may be recited either structurally of functionally, claims directed to an apparatus must be distinguished from the prior art in terms

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of structure rather than function. See MPEP §2114. Furthermore, the projection (30, 28) could perform the function stated above.

- b. a transverse leg (90) extending outwardly from the outer surface of the bottom portion of the arm towards a downwardly extending leg (42) of a wire channel.
- c. the wire channel having the downwardly extending leg (42), a channel portion (44), and a rear upwardly extending leg (40), wherein the downwardly extending leg (42) is longer than the rear upwardly extending leg (40) and wherein an interior (3) of the channel portion (44) defines a channel to retain a wire.
- 32. Regarding claim 2, Edwards in Figure 6 discloses a wire channel wherein the channel portion comprises a substantially "U"-shaped channel (44).
- 33. Regarding claim 12, Edwards in Figure 6 discloses a wire channel wherein the projection comprises at least one substantially hook-shaped lip (30, 28).
- 34. Regarding claim 13, Edwards in Figure 6 discloses a wire channel wherein the hook-shaped lip (30, 28) has an interior angle relative to the outer surface of the top portion of at least approximately fifteen degrees.
- 35. Regarding claim 14, Edwards in Figure 6 discloses a wire channel comprises at least one of the following materials: metal, polymer, plastic (Col 12, Ln 1-9).
- 36. Regarding claim 15, Edwards in Figure 6 discloses a wire channel comprising:
 - a. a transverse leg (90) extending outwardly towards a downwardly extending leg (42) of a wire channel, wherein the transverse leg is capable of

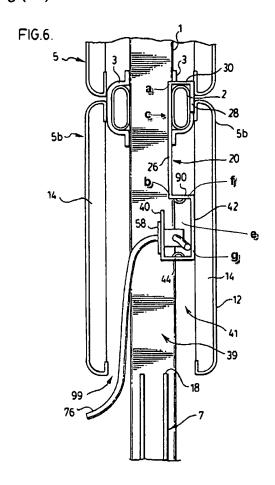
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extending beneath a rearwardly facing hook portion of an upper siding panel. As noted in paragraph 26 of this office action, for purpose of examination the claims are considered as directed to the wire channel device; therefore, the phrase "wherein the transverse leg extends beneath a rearwardly-facing hook portion of an upper siding panel" shall be considered as functional language.

- b. the wire channel having the downwardly extending leg (42), a channel portion (44), and a rear upwardly extending leg (40), wherein the downwardly extending leg (42) is longer than the rear upwardly extending leg (40) and wherein the channel portion (44) defines a channel (e) to retain a wire.
- 37. Regarding claim 16, Edwards in Figure 6 discloses a wire channel comprising:
 - a. at least one upwardly extending arm (26) having a top portion (a), a bottom portion (b), an inner surface (c), and an outer surface (20), the outer surface (20) of the top portion (a) having a projection (30, 28) capable of engaging and securing the wire channel device between the lip portion of the upper siding panel and a complimentary hooked portion of a lower siding panel. The phrase "to engage and to secure the wire channel device between the lip portion of the upper siding panel and a complimentary hooked portion of a lower siding panel" is regarded to as functional language and while features of an apparatus may be recited either structurally of functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP §2114. Furthermore, the projection (30, 28) could perform the function stated above.

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b. a portion of the outer surface (20) of the bottom portion (b) connected with the transverse leg (90).



Edwards (U.S. Patent No. 6,158,180).

Claim Rejections - 35 USC § 103

38. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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39. Claims 4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards ('180) in view of Zimmerman (U.S. Patent No. 6,329,599 B1). The prior art of Zimmerman will be used in reverse orientation.

- 40. Regarding claim 4, Edwards discloses a wire channel as discussed above but does not disclose a channel portion comprising a substantially "V"-shaped channel. However, Zimmerman in Figure 29 discloses a flanged conduit having a channel portion (a) comprising a substantially "V"-shaped channel (19). Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the wire channel of Edwards to include a channel portion comprising a substantially "V"-shaped channel as taught by Zimmerman to provide a channel with a variety of configurations (Col 2, Ln 19-21).
- 41. Regarding claim 10, Edwards discloses a wire channel as discussed above but does not disclose the downwardly extending leg extending downward at an angle of at least thirty degrees toward the arm. However, Zimmerman in Figure 29 discloses a flanged conduit having the downwardly extending leg (283) extending downward at an angle of at least thirty degrees toward the arm (297). Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the wire channel of Edwards to include the downwardly extending leg extending downward at an angle of at least thirty degrees toward the arm to provide a channel with a variety of configurations (Col 2, Ln 19-21).

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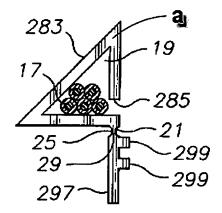


FIG. 29

Zimmerman (U.S. Patent No. 6,329,599 B1)

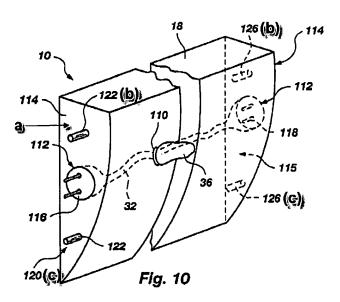
- 42. Claims 5, 6, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards ('180) in view of Brooks (U.S. Patent No. 5,823,655).
- 43. Regarding claims 5 and 17, Edwards discloses a wire channel as discussed above and also including transverse leg (90) comprising a first lateral side (f) and a second lateral side (opposite side of (f)) but does not disclose the first lateral side having a female repository and the second lateral side having a male projection, wherein the male projection of a first wire channel device mates with the female repository of a second wire channel device such that the first wire channel snap fits into alignment and secures with the second wire channel. However, Brooks in Figure 10 discloses channeled molding having a transverse leg (114) further comprising a first lateral side (115) and a second lateral side (a), the first lateral side having a female repository (126 (b)) and the second lateral side having a male projection (122 (b)),

wherein the male projection of a first wire channel device mates with the female repository of a second wire channel device such that the first wire channel snap fits into alignment and secures with the second wire channel (Col 7, Ln 54-56). Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the wire channel of Edwards to include the first lateral side having a female repository and the second lateral side having a male projection, wherein the male projection of a first wire channel device mates with the female repository of a second wire channel device such that the first wire channel snap fits into alignment and secures with the second wire channel as taught by Brooks to provide a means for extending the length of the channel.

44. Regarding claims 6 and 18, Edwards discloses a wire channel as discussed above and also including the downwardly extending leg (42) further comprising a first lateral side (g) and a second lateral side (opposite side of (g)) but does not disclose the first lateral side having a female repository and the second lateral side having a male projection, wherein the male projection of a first wire channel device mates with the female repository of a second wire channel device to align and secure the first wire channel device with the second wire channel device. However, Brooks in Figure 10 discloses channeled molding having a first lateral side (115) and a second lateral side (a), the first lateral side having a female repository (126 (c)) and the second lateral side having a male projection (122 (c)), wherein the male projection of a first wire channel device mates with the female repository of a second wire channel device such that the first wire channel snap fits into alignment and secures with the second wire channel (Col

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7, Ln 54-56). Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the wire channel of Edwards to include the downwardly extending leg further comprising a first lateral side having a female repository and the second lateral side having a male projection, wherein the male projection of a first wire channel device mates with the female repository of a second wire channel device such that the first wire channel snap fits into alignment and secures with the second wire channel as taught by Brooks to provide a means for extending the length of the channel. Furthermore, it has been held that the mere rearrangement of parts, such as the male projection and the female repository, would be a matter of design choice as the shifting of the positions would not have modified the operation of the device. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).



Brooks (U.S. Patent No. 5,823,655)

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45. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards ('180) in view of the opinions held by the court.

- 46. Regarding claim 7, Edwards discloses a wire channel as discussed above but does not disclose the length of the upwardly extending arm being at least about one inch. It would have been an obvious matter of design choice to modify the wire channel of Edwards to have the length of the upwardly extending arm at least about one inch, since such a modification would have involved a mere change in the size of the component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).
- 47. Regarding claim 8, Edwards discloses a wire channel as discussed above but does not disclose the length of the transverse arm being at least about one inch. It would have been an obvious matter of design choice to modify the wire channel of Edwards to have the length of the transverse arm at least about one inch, since such a modification would have involved a mere change in the size of the component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).
- 48. Regarding claim 9, Edwards discloses a wire channel as discussed above but does not disclose the downwardly extending leg being at least about one and a half inches. It would have been an obvious matter of design choice to modify the wire channel of Edwards to have the length of the downwardly extending leg at least about one and a half inches, since such a modification would have involved a mere change in

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the size of the component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Conclusion

- 49. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Zimmerman (U.S. Patent No. 5,514,834) a flanged conduit; Adams (U.S. Patent No. 5,141,192) a clip for hanging wiring; Mitchell (U.S. Patent No. 6,904,730 B2) a panel with multiple arms.
- 50. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine T. Cajilig whose telephone number is (571) 272-8143. The examiner can normally be reached on Monday Friday from 9am 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571) 272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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